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**JAN 25 2008**

**OFFICE OF PETITIONS**

In re Application of :  
Lipscomb, et al. :  
Application No. 09/942,347 : DECISION  
Filed: 29 August, 2001 :  
Attorney Docket No. CL/V-31575A :

This is a decision on the petition originally filed on 10 May, 2004, resubmitted on 15 August, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, the petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

Petitioner's Power of Attorney and Notice of Change of Address (filed on 15 August, 2007, is acknowledged and entered.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 26 August, 2003 with reply due absent extension of time on or before 26 November, 2003;
- the application went abandoned after midnight Wednesday, 26 November, 2003;

- the Office mailed the Notice of Abandonment on 2 April, 2004;
- it appears from documentation submitted by Petitioner that, on 10 May, 2004, Petitioner filed the original petition to withdraw the holding of abandonment with, *inter alia*, an averment that the reply (in the form of an amendment and terminal disclaimer with fee) to the Office action in question was filed over a 25 November, 2003, certificate of mailing on 28 November, 2003, and evidenced that event by a date-stamped ("NOV 28 2003") receipt card (see: MPEP§503)), and Petitioner seems to have provided with his petition copies of the amendment and terminal disclaimer (with fee);
- it does not appear that the Office replied to the filing of that 10 May, 2004, petition;
- Petitioner seems not to have inquired as to the status of the instant matter (and the lack of Office reply to the 10 May, 2004, petition) until on or about 15 August, 2007, when Petitioner resubmitted the request to withdraw the holding of abandonment, along with evidence of the prior filings in the form of a date-stamped ("MAY 10 2004") receipt card, and copies of the petition, and the earlier reply (amendment, terminal disclaimer and fee) and receipt card.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.<sup>1</sup>

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<sup>1</sup> See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

See specifically, the regulations at 37 C.F.R. §10.18.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>4</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup>

And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>)

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

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Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the basis for a petition seeking withdrawal of a holding of abandonment.<sup>7</sup> And the commentary at MPEP §711.03(c)(A) and (B) details the requirements therein. And the regulation requires that relief be sought within two (2) months of the act complained of.

Petitioner appears to have satisfied the burdens herein

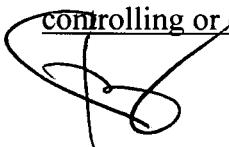
CONCLUSION

Petitioner appears to have satisfied the burdens herein, and the petition as considered under 37 C.F.R. §1.181 is granted, and the 2 April, 2004, Notice of Abandonment is vacated.

The instant application is released to Technology Center AU 3728 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the abandonment has been lifted by the Technology Center in response to this decision—and it is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center/Art Unit where that change of status must be effected.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>8</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

  
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Senior Attorney  
Office of Petitions

<sup>7</sup> See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

<sup>8</sup> The regulations at 37 C.F.R. §1.2 provide:  
**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.